

REMARKS

Claims 1 through 8 are pending in this application. Claim 1 has been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, page 13 of the written description of the specification, line 24. Applicants submit that the present Amendment does not generate any matter issue.

In the Office Action dated June 30, 2004, the following rejections were imposed:

- 1. Claims 1 through 6 were rejected under 35 U.S.C. §103 for obviousness predicated upon Ishakawa et al. in view of Ngo et al.;**
- 2. Claim 7 was rejected under 35 U.S.C. §103 for obviousness predicated upon Ishakawa et al. in view of Ngo et al. and Danziger et al.;**
- 3. Claim 8 was rejected under 35 U.S.C. §103 for obviousness predicated upon Ishakawa et al. in view of Ngo et al. and Eggleton et al.**

Each of the above rejections under 35 U.S.C. §103 is traversed. Specifically, independent claim 1 is directed to a optical transmission system comprising a dispersion compensating system. That dispersion compensating system compensates for both of chromatic dispersion and dispersion slope. However, the primary reference to Ishakawa et al. neither discloses nor suggests the concept of forming an optical transmission system comprising a dispersion compensating system which compensates for both of chromatic dispersion and dispersion slope. In fact, the notion of providing a dispersion compensating system for compensating dispersion slope is alien to Ishakawa et al. The secondary references to Ngo et al., Danziger et al. and Eggleton et al. do not cure the argued deficiencies of Ishakawa et al. Accordingly, even if the applied references are combined as

suggested by the Examiner, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicants, therefore, submit that the imposed rejection of claims 1 through 6 under 35 U.S.C. §103 for obviousness predicated upon Ishakawa et al. in view of Ngo et al., the imposed rejection of claim 7 under 35 U.S.C. §103 for obviousness predicated upon Ishakawa et al. in view of Ngo et al. and Danziger et al., and the imposed rejection of claim 8 under 35 U.S.C. §103 for obviousness predicated upon Ishakawa et al. in view of Ngo et al. and Eggleton et al. are not factually or legally viable and, hence, solicit withdrawal thereof.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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